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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/550,111

09/19/2005

Stephen D. Goble

21265P

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7590

08/06/2007

MERCK AND CO., INC

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RAHWAY, NJ 07065-0907

EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

08/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/550,111 | GOBLE ET AL. | |
| | Examiner | Art Unit | |
| | Kahsay Habte | 1624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-37 are pending in this application.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3 (in part), 5, 10-13 (in part), 17-19 (in part) and 22-37 (in part), drawn to 1,3-benzothiazines (i.e. B = S and A = X = D = carbon).

Group II, claim(s) 1-3 (in part), 4, 10-13 (in part), 17-19 (in part) and 22-37 (in part), drawn to 1,3-benzoxazines (i.e. B = O and A = X = D = carbon).

Group III, claim(s) 1-3 (in part), 6, 10-13 (in part), 17-19 (in part) and 22-37 (in part), drawn to quinoxalines (i.e. B = N and A = X = D = carbon).

Group IV, claim(s) 1-3 (in part), 7, 10-13 (in part), 17-19 (in part) and 22-37 (in part), drawn to phthalazines (see claim 7).

Group V, claim(s) 1-3 (in part), 8, 10-13 (in part), 17-19 (in part) and 23-37 (in part), drawn to naphthyridines (see claims 8 and 9).

Group VI, claim(s) 1-3 (in part), 10-13 (in part), 14-16, 17-19 (in part) and 20-37 (in part), drawn to others.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of Group I is a benzothiazine ring (benzo ring fused to 1,3-thiazine ring) and is

Art Unit: 1624

different from the special technical feature of Groups II-VI. The special technical feature of Group II is a benzoxazine ring (benzo ring fused to 1,3-oxazine ring) and is not present in the special technical feature of Group I of Groups III-VI. The special technical feature of Group III is a quinoxaline ring (benzo ring fused to 1,3-diazine ring) and is different from the special technical feature of Groups I-II and Groups IV-VI. The special technical feature of Group IV is a phthalazine ring (benzo ring fused to 1,2-diazine ring) and is different from the special technical feature of Groups I-III and Groups V-VI. The special technical feature of Group V is a naphthyridine ring (a pyrido ring fused to another monoazine ring) and is different from the special technical feature of Groups I-IV and VI. The special technical feature of Group VI is other heterocyclic rings that are not covered by Groups I-V e.g. 1,2-diazne ring fused to pyrido ring, oxazines ring fused to pyrido ring, etc. and is different from the special technical feature of Groups I-V.

If applicants elect Group VI, an election of a single disclosed species is required.

A telephone call was made to Mr. David Rubin on July 26, 2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Note that claim 18 is improperly dependent on claim 16. In order to expedite prosecution, it is recommended that applicants delete method claims 35-36 that may have enablement issues.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone

Art Unit: 1624

number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', is written over the printed name.

Kahsay Habte
Primary Examiner
Art Unit 1624

July 31, 2007